REMARKS

Reconsideration of the present application is respectfully requested.

I. The Examiner's Rejections/Objection

Claims 1-2 and 4-8 are in the application. In the Office Action mailed February 13, 2006, the Examiner: (a) rejected claim 1 in its unamended form under 35 U.S.C. § 102 as anticipated by U.S. Patent No. 5,827,228 to Rowe ("Rowe patent"); (b) rejected claims 2 and 6-8 under 35 U.S.C. § 102 as anticipated by the Rowe patent; (c) rejected claims 4 and 5 under 35 U.S.C. § 103 as being unpatentable over the Rowe patent in view of U.S. Patent No. 5,792,113 to Kramer ("Kramer patent"); and (d) objected to the drawings since they did not show a domed protrusion 14A as described in the specification.

II. The Amendment to the Drawings

FIG. 2 of the drawings as filed did illustrate a flapper door 14 with a domed protrusion. However, FIG. 2 did not contain the reference designator "14A." Since FIG. 2 of the drawings has been amended by this response to include the reference designator "14A" for the domed protrusion, Applicants submit that the objection to the drawings should be withdrawn.

III. The Amendments to Claim 1

The minor amendments to claim 1 are made to improve the language of claim 1 and are not made in response to the Examiner's rejection. The amendments to claim 1 are not, therefore, "narrowing amendments" as that term is utilized in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 732 (2002).

IV. The Rowe Patent Does Not Anticipate Claim 1

For the following reasons, the rejection of claim 1 under 35 U.S.C. § 102 based on the Rowe patent is respectfully traversed.

A. Standard for Anticipation

Anticipation under § 102 can be found only if a reference shows **exactly** what is claimed. *Titanium Metals Corp. v. Banner,* 778 F.2d 775, 780 (Fed. Cir. 1985). A prior art reference must thus describe all of the elements in a claim, arranged as in the claim, for the reference to be an anticipation. *C.R. Bard, Inc. v. M3 Systems Inc.,* 157 F.3d 1340, 1349 (Fed. Cir. 1998). There must be **strict identity** between the claim at issue and the prior art reference for anticipation to exist. *Trintec Industries, Inc. v. Top-U.S.A. Corp.,* 295 F.3d 1292, 1296 (Fed. Cir. 2002) (reference disclosing a color printer did not anticipate a claim requiring a color photocopier).

B. The Trocar Seal Described in the Rowe Patent

Rowe discloses an elastomeric seal member 134 which includes a generally planar inner section 144 and an outer section 146. An opening 148 is formed through inner section 144 and is sized to permit an obturator or other implement to pass through the opening in sealing engagement with the opening. Outer section 146 is formed with a distally extending peripheral wall or flange portion 152 having an inwardly facing annular groove or recess 154 formed therein. Flange portion 152 is generally in alignment with corrugated portion 150. A tongue portion 156 associated with the flap valve assembly 136 is received in sealed relationship with groove 154. (See, Rowe patent, column 6, lines 25-41 and Fig. 5).

The Rowe patent thus describes a trocar seal which is installed in and permanently a part of the trocar assembly.

C. The Differences between Claim 1 of the Present Application and the Rowe Patent

In sharp distinction to the seal disclosed by the Rowe patent, a seal in accordance with the present invention is not for installation **in** a trocar, but rather for installation **on** a trocar, as recited in claim 1 of the present application. FIG. 6 of the present application illustrates a seal according to the present invention which is installed on the trocar. Claim 1 further specifies that Applicants' trocar seal has a lower portion which is formed for mating engagement with the access port and FIG 6 shows such engagement. The Rowe patent does not describe a seal for any such engagement, but rather describes, as noted above, a seal which is permanently in the trocar assembly. [1] Since, the Rowe patent does not describe exactly what is called for in claim 1, the Rowe patent is not an anticipation of claim 1.

These differences between what is called for by claim 1 and what is disclosed in the Rowe patent are significant. It is well known that seals in a trocar have a fatigue life. That is, during a surgical procedure, the seals of a trocar may cease to function properly due damage and wear and tear from the repeated passage of instruments through the seal. In the event that a seal as disclosed in Rowe ceases to function properly, the entire trocar must be discarded and replaced. A trocar utilizing a seal in accordance with the present invention will only have to replace the seal which is in mating engagement with the access port on the exterior of the trocar, when the seal ceases to function.

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[1] The seal 20 described in the Kramer patent is also installed in and permanently part of the trocar handle 10. *See*, Kramer patent, Fig. 3. Thus any reliance on a combination of the Rowe and Kramer patents to reject Claim 1 would be misplaced.

Additionally, utilizing a seal as disclosed in the Rowe patent results in the obturator, as well as other surgical instruments, passing through the seal during the course of a surgery. In contrast, when a seal in accordance with the present invention is utilized, the obturator is not passed through the seal. Rather, a seal in accordance with the present invention is installed on the access port once the obturator has penetrated the patient and has been removed from the trocar.

V. Claims 4-8 define patentable subject matter.

The well-established law is that if an independent claim is patentable, then the claims dependant from that independent claim are also patentable. *In re Fine,* 837 F.2d 1071, 1076 (Fed. Cir. 1988) ("Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious); *Schumer v. Laboratory Computer Systems, Inc.,* 308 F.3d 1304, 1316 (Fed. Cir. 2002) (district court erred in ruling that dependent claim 14 was invalid merely because it depended from independent claim 13 which had been found to be invalid for anticipation).

Thus, the § 102 rejection of claims 2 and 6-8 and the § 103 rejection of claims 4-5 must be withdrawn, because these rejections are premised on the erroneous rejection of claim 1 as being anticipated by the Rowe patent.

VI. Conclusion

The present application is in a condition for allowance, and such action is requested. If the Examiner is of the view that any matter exists that would somehow preclude allowance, the Examiner is requested to telephone the undersigned to resolve such matter.

Respectfully submitted,

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DRAWING AMENDMENTS

Please substitute the "Replacement Sheet" drawing (Attachment A) for page 2 of the drawings as filed. In FIG. 2 of the replacement sheet, the reference designator "14A" has been added.